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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,901	08/28/2001	Howard W. Lutnick	CF/031	7586
1473	7590	08/27/2004	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			MCCLELLAN, JAMES S	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/941,901

Applicant(s)

LUTNICK ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/16/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. Applicant's submission of an Information Disclosure Statement on November 16, 2001 has been fully considered as indicated by the attached signed PTO-1449.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the steps of claims 1-9 and 11-20 fail to apply, involve, use, or advance the technological arts. The steps of claims 1-9 and 11-20 can be carried out manually

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without applying, involving, using, or advancing the technological arts. Claim 10 is not rejected under 35 U.S.C. § 101 because it applies, involves, and uses displaying information to a web page. In order to overcome the 35 U.S.C. § 101 rejection, the examiner recommends amending claims 1, 15, and 16 to include a positive recitation in the body of the claim of applying, involving, using, or advance the technological arts. For example, claim 1 of cited U.S. Patent No. 6,085,176 to Woolston sets forth a method that positively applies, involves, uses, and advances the technological arts.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9, 11, 13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,992,940 (hereinafter "Dworkin") in view of the Examiner's assertion of Official Notice.

Regarding **claim 1**, Dworkin discloses a method for interactively assisting purchase-decision-making, comprising: receiving data relating to purchasing options (see column 5, lines 35-42), the options including shopping for goods and services (see column 5, line 1); querying based on the data (via database 3); receiving a response to the querying (see column 6, lines 16-25; Figure 6); and guiding purchase decision-making based on the data and the response until a final purchase selection is indicated (by displaying responses relevant to request; see Figure 6);

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**[claim 3]** generating at least one selectable list of purchase categories and receiving at least one selection of a purchase category (see column 4, lines 67-68); **[claim 4]** generating a plurality of selectable lists or purchase categories (see Figure 4); **[claim 5]** transmitting the user data to a seller or provider of service (see column 4, lines 19-20); **[claim 6]** receiving seller or service provider data based on the transmitting (see column 4, lines 19-20); **[claim 7]** receiving seller or provider of service data (see column 10, lines 50-53); **[claim 8]** analyzing data from a seller or a provider of service in order to make a purchase recommendation (see Figure 6); **[claim 9]** relaying data to a seller or provider or service, in order to finalize a purchase transaction (see column 4, lines 19-24); **[claim 11]** enabling a plurality of purchase transactions to be made (it is inherent that more than one purchase is enabled); and **[claim 13]** calculating a total purchase cost associated with a purchasing selection (calculation of total cost is inherent during transaction payment).

Dworkin fails to explicitly disclose receiving data related purchasing options, wherein the options including investing [as required by claims 1 and 2] and traveling [as required by claim 3]. Dworkin's invention is related to receiving data related to purchasing option, wherein the options include any good or service.

The Examiner takes Official Notice that it was old and well known at the time the invention was made to receive investing and traveling purchase options.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dworkin with purchasing options specific to investing and traveling, because investing and traveling purchasing are more efficiently conducted using a computer system.

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Regarding **claims 15, 16, and 17**, the Examiner relies on the same analysis as set forth above for similar method claim 1.

6. Claims 10 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin in view of Official Notice as applied to claim 1 above, and further in view of U.S. Patent No. 6,085,176 (hereinafter “Woolston”).

Regarding **claim 10**, Dworkin fails to explicitly disclose an interface for receiving information from and displaying information to a web page.

Woolston teaches the use of a web page user interface (see column 9, lines 10-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dworkin with a web interface as taught by Woolston, because web interfaces are easily navigated and understood by computer users.

Regarding **claims 18-20**, Dworkin fails to disclose transmitting and receiving counter offers.

Woolston teaches the use of transmitting and receiving counter offers (see column 8, lines 32-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dworkin with the transmission of counter offers as taught by Woolston, because using counter-offers allows both parties to negotiate the final purchase price of the transaction wherein empowering both the buyer and selling to optimize their profits (seller) and costs (buyer).

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7. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin in view of Official Notice as applied to claim 1 above, and further in view of U.S. Patent Application No. US 2002/0113809 (hereinafter "Akazawa").

Regarding **claims 12 and 14**, Dworkin fails to explicitly disclose receiving information relating to the total amount of money available for purchase purpose and comparing the available money to total purchase cost.

Akazawa teaches comparing a budget amount with purchase cost (see Figure 5, "Question 2").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dworkin with the monetary budget taught by Akazawa, because setting available spending guidelines allows the system to better match the customer's needs.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Peckover and Lin are cited of interest for disclosing shopping agents for electronic commerce.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

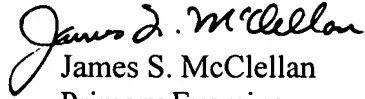
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks  
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or  
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

  
James S. McClellan  
Primary Examiner  
A.U. 3627

jsm  
August 25, 2004